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To: **Mail Stop Appeal Brief- Patents**
United States Patent and Trademark Office
Fax No.: (703) 872-9306
From: George M. Macdonald
Date: May 5, 2004
Subject: Serial No.: 10/036,982
Pages: 14 (including this cover)

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Re: U.S. Patent Application Serial No.: 10/036,982
Our Docket # F-423

Enclosed please find Appellants' Brief on Appeal and a petition for one-month extension of time.

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following correspondence is being transmitted
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U.S. Patent and Trademark Office
Examiner Joseph C. Rodriguez, GAU 3653
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1. Petition for One-Month Extension of Time and Fee (1 page); and
2. Appellant's Brief on Appeal (12 pages).

on May 5, 2004
Date of Transmission

George M. Macdonald
Name of Registered Rep.
Reg. No.: 39,284


Signature

May 5, 2004
Date

Serial No.: 10/036,982
 Attorney Docket No.: F-423

Patent

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
 BOARD OF PATENT APPEALS AND INTERFERENCES**

MAY 05 2004

In re patent application of:

) Attorney Docket No.: F-423
) Customer No.: 00919
)
) Examiner: Joseph C. Rodriguez
) Group Art Unit: 3653
)
) Date: May 5, 2004

William E. Ryan, et al.

Serial No.: 10/036,982
 Filed: December 31, 2001
 Confirmation # 5328

Title: **SYSTEM FOR DETECTING THE PRESENCE OF HARMFUL
 MATERIALS IN INCOMING MAIL STREAM**

Mail Stop Appeal Brief- Patents
 Commissioner for Patents
 Alexandria, VA 22313-1450

OFFICIAL

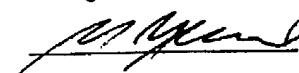
APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 *et seq.* from the final rejection of claims 1-11 of the above-identified application mailed November 6, 2003. Claims 1-11 stand at least twice rejected. This Brief is in furtherance of the Notice of Appeal filed in this case on February 5, 2004. A petition for one-month extension to file the brief and fee is submitted herewith. Accordingly, this brief is timely filed. This Brief is transmitted in triplicate. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. 16-1885 in the amount of \$330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885. Enclosed with this original are two copies of this brief.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on May 5, 2004 (Date of Transmission).
 George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)

 (Signature) May 5, 2004 (Date)

(10025731.1)

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Patent

I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-11 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2003/0058099 A1 by Lopez, et al. ("Lopez '099") in view of U.S. Patent Application Publication No. US 2002/0124664 A1 by Call, et al. ("Call '664").

Claims 1-11 are under further final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2003/0058099 A1 by Lopez, et al. ("Lopez '099") in view of U.S. Patent Application Publication No. US 2002/0124664 A1 by Call, et al. ("Call '664") and further in view of U.S. Patent No. 6,169,936 to Lohmann ("Lohmann '936") and U.S. Patent No. 6,303,889 to Hayduchok, et al. ("Hayduchok '889").

Appellants hereby appeal the rejection of claims 1-11.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of November 6, 2003. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Invention

Appellants' invention relates to methods and systems for detecting the presence of harmful materials in an incoming mail stream. Figures 8a and 5d are reproduced below for use in a summary discussion of an illustrative embodiment. As can be appreciated, a system of processing incoming mail is provided that integrates detection with mailpiece processing so as to help deter delays in incoming mail delivery caused

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by the presence of life harming material and sanitize the mail so as to protect the intended recipients from harm. This in turn affords for less delays in mailpiece processing.

As shown below, an embodiment using an x-ray module detector 23a is shown. Configurations for separating sections of the system 152 into detection room (left side) and clean room (right side) minimize exposure to and contain possible harmful elements that are emitted from or are in the mail stream. Operators in the detection room may be outfitted with expensive personal protective equipment. The detection room has a negative pressure as compared to the clean room and appropriate filtration and sealing can be provided in transition area 43 of the feed path F that is a passage between the clean room and detection room.

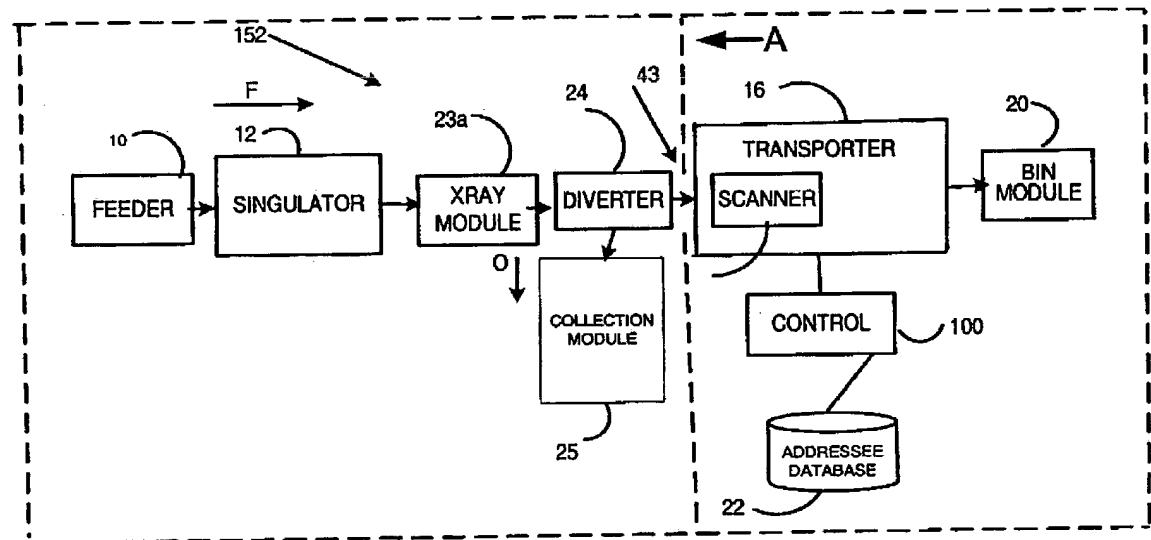


FIG. 8a

If the detector is an x-ray module 23a, it is important to provide a scanning gap to allow the sample to be tested. If the x-ray image contains portions that are interpreted to be suspect, then the system can divert the mailpiece to collection module 25. The system 152 of Figure 8a can also include the detection room 41 and clean room 42 configuration described above, with air flow between the detection room and the clean room shown generally with arrow A.

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The detector can be configured as shown below in FIG. 5d so as to move mailpieces along feed path F the gap between vertically oriented belts. Detection occurs in area 44 between components 13a and 13b that in this embodiment are detection apparatus.

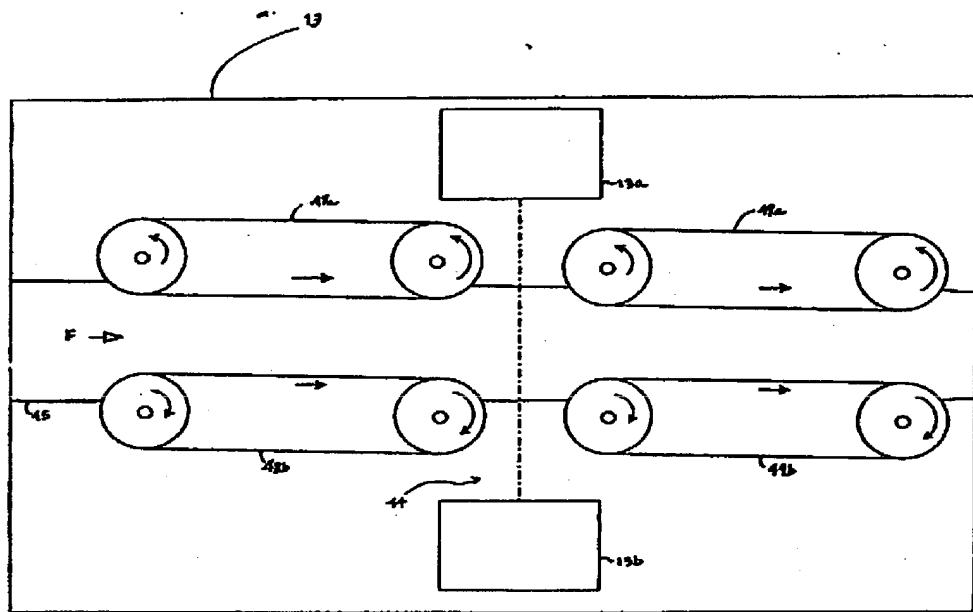


FIG. 5d

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Issues

Whether claims 1-11 are patentable under 35 U.S.C. §103(a).

VII. Grouping of Claims

(10025731.1)

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Claims 1-11 are grouped in the following groups:

Group I – Claims 1-2.

Group II - Claims 3-10.

Group III – Claim 11.

In Group I, independent claim 1 and claim 2 that depends directly from claim 1 stand or fall together.

In Group II, dependent claim 3 and claims 4-10 that depend directly or indirectly from claim 1 stand or fall together.

In Group III, claim 11 that depends indirectly from claim 1 stands or falls alone.

VIII. Argument

As Appellants discuss in detail below, the final rejection of several of claims 1-17 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a *prima facie* case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The Call '664 Reference is Not Properly Combined Under 35 U.S.C. Section 103(a)

Initially, the Examiner relies on the filing date of a related provisional patent application and continuation-in-part application in the Call '664 reference, yet does not provide a copy of the earlier reference to support entitlement to the earlier filing date for the material cited. Accordingly, the reference is not available as prior art.

B. Claims 1-2 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 1-2 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2003/0058099 A1 by Lopez, et al. ("Lopez '099") in view of U.S. Patent Application Publication No. US 2002/0124664 A1 by Call, et al. ("Call '664").

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Claims 1-2 also stand alternatively rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious Lopez '099 in view of Call '664 and further in view of U.S. Patent No. 6,169,936 to Lohmann ("Lohmann '936") and U.S. Patent No. 6,303,889 to Hayduchok, et al. ("Hayduchok '889").

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, *supra*; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Claim 1 is directed to a system for sorting mailpiece and detecting the presence of harmful materials in the mailpieces and is shown below:

1. A system for sorting mailpiece and detecting the presence of harmful materials in the mailpieces, the system comprising:
 - a component for singulating and feeding a mailpiece along a feed path of the system;
 - a detection module positioned downstream of the component for singulating and feeding the mailpiece, the detection module for detecting the presence of harmful material in the mailpiece;
 - a diverter for diverting the mailpiece into a collection module if harmful material is detected by the detection module as being present in the mailpiece;
 - a filtered transition area downstream of the diverter;

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a system for reading the mailpiece and determining a destination bin if the detection module does not detect the presence of harmful material in the mailpiece; and
a bin module comprising two or more destination bins for receiving a mailpiece after a destination bin has been determined by the system for reading the mailpiece and determining the destination bin. (emphasis added).

In the November 6, 2003 Final Office Action, the Examiner rejected claims 1-2 under 35 U.S.C. section 103(a). Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

The Examiner cites to Call '664 to show a filtered transition area downstream of the diverter, but Call does not teach or suggest a filter downstream of the diverter. Call '664 does not even appreciate the problem of efficiently scanning for harmful materials and routing the mail such that the process is expedited. Contrary to the position taken by the Examiner, it does not necessarily logically flow that Lopez '099 would apply a detection and clean area. The system of Call '664 does not teach screening and routing in a single integrated system and Lopez '099 does not teach or suggest how to apply a detection and clean area to such an integrated system. The claims of the present invention cannot be used in an application of hindsight to achieve that combination.

Furthermore, neither of the references teaches nor suggests determining a destination bin that is further used to expedite mail processing.

Similarly, the alternative rejection presented by the Examiner does not establish a prima facie obviousness rejection for the reasons stated above and further because there would be no motivation to combine those teaching other than by using improper hindsight and the present claims describing the integrated screening and destination determining bin system.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Independent claim 2 includes similar elements and is patentable over the cited references for at least the same reasons. For at least the above stated reasons, Appellants respectfully submit that the final rejection as to claims 1-2 is in error and should be reversed.

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C. Claims 3-10 are Not Unpatentable Under 35 U.S.C. section 103(a)

Claim 3 is directed to a system for sorting mailpiece and detecting the presence of harmful materials in the mailpieces and is shown below:

3. The system as claimed in claim 1 wherein the detection module comprises:

a first set of guide walls, each guide wall in the first set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

a second set of guide walls positioned down stream of the first set of guide walls along the feed path and forming a gap along the feed path between the first set of guide walls and the second set of guide walls, each guide wall in the second set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path; and

a detection apparatus positioned along the feed path in the area of the gap along the feed path between the first set of guide walls and the second set of guide walls. (emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above. Claim 3 is patentable over the cited references for at least the reasons discussed above. Furthermore, the cited references fail to teach or suggest a feed path gap used to facilitate detection of harmful material. The gap provides a clear detection path having no feed path components to interfere with the detection operation.

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. The referenced dependent claims are patentable over the cited references for at least the reasons discussed above regarding the respective independent claims. For at least the above stated reasons, Appellants respectfully submit that the final rejection as to claims 3-10 is in error and should be reversed.

D. Claim 11 is Not Unpatentable Under 35 U.S.C. section 103(a)

Claim 11 depends indirectly from claim 1 and is patentable for at least the reasons as described above with reference to claims 1 and 10.

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Furthermore, claim 11 recites:

11. The system as claimed in claim 10 further comprising:

a clean area, the clean area for containing the bin module, the clean area connected to the detection area at a transition area, the detection area having an area pressure lesser than an air pressure in the clean area whereby air flow is from the clean area to the detection area. (emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above. For example, the cited references do not show a separate detection area and clean area for components of a system for screening and determining an output bin for mail.

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claim 11 is in error and should be reversed.

IX. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-11 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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APPENDIX A

1. A system for sorting mailpiece and detecting the presence of harmful materials in the mailpieces, the system comprising:
 - a component for singulating and feeding a mailpiece along a feed path of the system;
 - a detection module positioned downstream of the component for singulating and feeding the mailpiece, the detection module for detecting the presence of harmful material in the mailpiece;
 - a diverter for diverting the mailpiece into a collection module if harmful material is detected by the detection module as being present in the mailpiece;
 - a filtered transition area downstream of the diverter;
 - a system for reading the mailpiece and determining a destination bin if the detection module does not detect the presence of harmful material in the mailpiece; and
 - a bin module comprising two or more destination bins for receiving a mailpiece after a destination bin has been determined by the system for reading the mailpiece and determining the destination bin.

2. The system as claimed in claim 1 wherein the system for reading the mailpiece and determining a destination bin comprises:

a control system for providing processing of information read from the mailpiece and an addressee database for providing addressee information which is compared to information read from the mailpiece in order to determine the appropriate addressee and destination bin for the mailpiece.

3. The system as claimed in claim 1 wherein the detection module comprises:

a first set of guide walls, each guide wall in the first set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

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a second set of guide walls positioned down stream of the first set of guide walls along the feed path and forming a gap along the feed path between the first set of guide walls and the second set of guide walls, each guide wall in the second set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path; and

a detection apparatus positioned along the feed path in the area of the gap along the feed path between the first set of guide walls and the second set of guide walls.

4. The system as claimed in claim 3 and whereby the presence of harmful material in the mailpiece is detected as the mailpiece passes by the gap along the feed path between the first set of guide walls and the second set of guide walls.

5. The system as claimed in claim 3 wherein the detection apparatus comprises at least one apparatus from the group comprising: an x-ray apparatus, a laser, an infrared spectrascope or a scanner.

6. The system as claimed in claim 3 wherein at least a portion of the feed path comprises a transport belt which travels along an edge of the first set guide walls and an edge of the second set of guide walls.

7. The system as claimed in claim 1 wherein the detection module comprises:

a first set of first and second driven belts, each driven belt in the first set of driven belts positioned parallel to the feed path and facing the other driven belt and forming an alley along the feed path;

a second set of first and second driven belts positioned down stream of the first set of first and second driven belts along the feed path and forming a gap along the feed path between the first set of first and second driven belts and the second set of first and second driven belts, each driven belt in the second set of driven belts

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positioned parallel to the feed path and facing the other driven belt forming an alley along the feed path; and

a detection apparatus positioned along the feed path in the area of the gap along the feed path between the first set of driven belts and the second set of driven belts.

8. The system as claimed in claim 7 wherein the detection apparatus comprises at least one apparatus for the group consisting of: an x-ray apparatus, a laser, an infrared spectrascope and a scanner.

9. The system as claimed in claim 7 wherein at least a portion of the feed path comprises a transport belt which travels along an edge of the first set of first and second driven belts and the second set of first and second driven belts.

10. The system as claimed in claim 1 further comprising:

a detection area, the detection area containing the component for singulating and feeding a mailpiece, the detection module and the collection module.

11. The system as claimed in claim 10 further comprising:

a clean area, the clean area for containing the bin module, the clean area connected to the detection area at a transition area, the detection area having an area pressure lesser than an air pressure in the clean area whereby air flow is from the clean area to the detection area.